

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CARCAGNO *et al.*

Application No.: 09/830,968

§ 371(c) Date: November 6, 2001

For: **Method for the Massive Culture of
Cells Producing Recombinant
Human Erythropoietin**

Confirmation No.: 7301

Art Unit: 1632

Examiner: Wilson, Michael C.

Atty. Docket: 1909.0040002/PAJ/LMB

Comments on Statement of Reasons for Allowance

Mail Stop Issue Fee

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants thank the Examiner for indicating the allowability of claims 1, 3-5, 7-13, 16 and 20 in the Notice of Allowance dated August 7, 2009.

In the Reasons for Allowance, the Examiner states that:

[t]he species of "sodium pyruvate" in claim 1 implies the genus was not contemplated in the specification as originally filed. ... The broader scope of pyruvate is not readily apparent from the narrower embodiment. The species of sodium pyruvate in Tables 1-3 does not imply other species of pyruvate such as calcium pyruvate. Accordingly, the narrower scope of sodium pyruvate does not imply applicants contemplated using the broader scope of any pyruvate in culture medium.

Applicants argue the species of sodium pyruvate implies applicants had contemplated the broader genus. Applicants' argument is not persuasive. The species of sodium pyruvate in Tables 1-3 (pg 13-14) does not imply other species of pyruvate such as calcium pyruvate.

Pages 2-3 of the Notice of Allowability.

Applicants respectfully disagree for at least the reasons provided in the Amendment and Reply Under 37 C.F.R. § 1.114 filed on July 10, 2009 and the Amendment and Reply Under 37 C.F.R. § 1.116 filed on June 9, 2009.

However, in the Reasons for Allowance, the Examiner indicates that the "rejection of claims 1, 3-5, 7-13, 16 and 20 under 35 U.S.C. 112, first paragraph, new matter has been *withdrawn*." Page 2 of the Notice of Allowability (*emphasis added*). Further, the Examiner did not express any concerns or rejections of the use of the term "pyruvate" in the claims during the telephone conversations between the Examiner and Applicants' representative on July 22, 2009 and July 29, 2009, and only indicated during those conversations that the new matter rejection would be withdrawn. As such, it is Applicants' understanding that the Examiner's statements regarding sodium pyruvate in the Reasons for Allowance were made in error.

Applicants respectfully request that the Examiner clarify the record in the event that he disagrees with any of the above comments on the Statement of Reasons for Allowance.

Respectfully submitted,

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Date: 11/09/2009

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